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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/456,516	12/08/1999	KLAUS MULLER	732/000012	6567

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KEIL & WEINKAUF  
1350 CONNECTICUT AVENUE, N.W.  
WASHINGTON, DC 20036

EXAMINER

TSOY, ELENA

ART UNIT PAPER NUMBER

1762

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/456,516

Applicant(s)

MULLER ET AL. 

Examiner

Elena Tsoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-6,8-10,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-10,13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Amendment***

1. Amendment filed on May 3, 2004 has been entered. Claims 2, 11 and 12 have been cancelled. Claim 14 has been added. Claims 1, 3-6, 8-10, 13, 14 are pending in the application.

***Election/Restrictions***

2. Applicant's election of Group I, claims 1, 3-6, 8-10, in the reply filed on May 3, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4, 8-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 5,139,854) in view of Klapper et al (US 5,312,848) for the reasons of record as set forth in Paragraph No. 2 of the Office Action mailed on December 10, 2003 because the thickness of the composite of Johnson is within claimed range of claim 14 (See column 6, lines 54-55).

5. Claims 1, 4, 5, 8, 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ellison et al (US 5,342,666) in view of Johnson (US 5,139,854) and Klapper et al (US 5,312,848) for the reasons of record as set forth in Paragraph No. 3 of the Office Action mailed

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on December 10, 2003 because the thickness of the composite of Ellison et al is within claimed range of claim 14 (See column 6, lines 54-55).

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 5,139,854) in view of Klapper et al (US 5,312,848) for the reasons of record as set forth in Paragraph No. 2 of the Office Action mailed on December 10, 2003 because a layer 3 in Johnson providing adhesion of a decorative layer 2 to a backing layer 4 (See column 6, lines 22-29) can be viewed as claimed primer layer applied to the backing layer 4.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellison et al (US 5,342,666) in view of Johnson (US 5,139,854) and Klapper et al (US 5,312,848) for the reasons of record as set forth in Paragraph No. 2 of the Office Action mailed on December 10, 2003 because a bonding layer 14 in Ellison et al providing adhesion of a decorative layer to a backing layer (See column 5, lines 56-60; column 6, lines 8-9) can be viewed as claimed primer layer applied to the backing layer.

8. Claim 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 5,139,854) in view of Klapper et al (US 5,312,848), and further in view of Miyakoshi (US 5,827,788) for the reasons of record as set forth in Paragraph No. 4 of the Office Action mailed on December 10, 2003.

9. Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 5,139,854) in view of Klapper et al (US 5,312,848), and further in view of Pelzer (US 6,019,923) for the reasons of record as set forth in Paragraph No. 5 of the Office Action mailed on December 10, 2003.

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 5,139,854) in view of Klapper et al (US 5,312,848) for the reasons of record as set forth in

Paragraph No. 2 of the Office Action mailed on December 10, 2003 because the thickness of the composite of Johnson is within claimed range of claim 14 (See column 6, lines 26-29, 45-45).

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellison et al (US 5,342,666) in view of Johnson (US 5,139,854) and Klapper et al (US 5,312,848) for the reasons of record as set forth in Paragraph No. 3 of the Office Action mailed on December 10, 2003 because the thickness of the composite of Ellison et al is within claimed range of claim 14 (See column 6, lines 54-55).

***Response to Arguments***

12. Applicants' arguments filed May 3, 2004 have been fully considered but they are not persuasive.

Applicants argue that claimed invention is not obvious over prior art of the record because neither of cited references of Johnson, Ellison et al, Klapper et al or Miyakoshi suggests a significant improvement in the tensile modulus of a layered composite.

The Examiner respectfully disagrees with this argument. First of all, a 5-layered composite of Johnson in view of Klapper et al or Ellison et al in view of Johnson and Klapper et al would *inherently* have a significant improvement in the tensile modulus compared to a 3-layered composite having the decorative layer and the heat-cured layer only on one side of the backing layer since the claimed and prior art products would be substantially identical in structure and composition. Secondly, one of ordinary skill in the art at would have reasonably expected that the tensile modulus of a 5-layered composite of Johnson in view of Klapper et al or Ellison et al in view of Johnson and Klapper et al having a decorative layer and a heat-cured layer on both sides of a backing layer would be significantly higher than that of a 3-layered

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composite having a decorative layer and a heat-cured layer only on one side of a backing layer simply because a 5-layered composite has two more layers than a 3-layered composite.

### *Conclusion*

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'ETsoy'.

Elena Tsoy  
Primary Examiner  
Art Unit 1762

June 7, 2004